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MAILED

SEP 22 2010

OFFICE OF PETITIONS

In re Patent No. 6,212,255 :
Issue Date: April 3, 2001 :
Application No. 09/383,226 : DECISION ON PETITION
Filed: August 26, 1999 : UNDER 37 CFR 1.378(b)
For: SYSTEM FOR X-RAY IRRADIATION :
OF BLOOD :

This is a decision on the petition under 37 CFR 1.378(b), filed April 20, 2010.

The petition under 37 CFR 1.378(b) for reinstatement of expired patent is hereby **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued April 3, 2001. The 3.5 year maintenance fee could have been paid from April 3, 2004 through October 3, 2004 without a surcharge, or with a surcharge during the period from October 4, 2004 through April 3, 2005. Accordingly, the patent expired on April 3, 2005 for failure to timely submit the second maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item requirement (1) set forth above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

Petitioner states that neither patentee nor attorney Leo Aubel has any record or recollection of having received the UPSTO Notice mailed October 20, 2004. Petitioner indicates that the mail recipient for the patent was attorney Leo Aubel. Petitioner indicates Attorney Aubel's standard of practice was to maintain such records. Petitioner further states that patentee and Attorney Aubel also "have a standard of practice" whereby Attorney Aubel notifies patentee and receives money from patentee for paying fees, such as the missed maintenance fee payment. Petitioner states patentee has no record of receiving notice of the maintenance fee due date, no record indicating payment of the maintenance fee, or any bank records indicating instructions were given to pay the maintenance fee.

Petitioner further states that the patentee became aware that the patent was expired in a federal court pleading in which a "licensee of the Patent claimed a breach for the patent having gone abandoned." The pleading was received by litigation counsel on April 8, 2010.

Inventor Kirk declared he was to "approve and issue payment for renewal of the Patent." Inventor Kirk indicates he and Attorney Aubel "established a method for payment of fees surrounding certain patents" and that the method of payment was by check. Inventor Kirk indicates he has no records of any transactions involving the patent subsequent to the issue fee payment.

Attorney Aubel declares he prepared and prosecuted the application which issued as the instant patent.

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Insofar as patentee's apparent lack of receipt of a USPTO Notice mailed October 20, 2004, patentee is reminded that failure to receive a Maintenance Fee Reminder from the USPTO will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b). See, In re Patent No. 4,409,763, 7 USPQ2d 1798

(Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992). In essence, patentee must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment from the time the payment was due until the filing of a grantable petition. Petitioner has failed to meet this burden.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a sufficient showing that any steps were employed by petitioner or anyone else. In the absence of a showing that patentee or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

Petitioner fails to establish that patentee, or someone obligated by behalf of patentee, was aware of the need to pay the maintenance fee and was in fact tracking the maintenance fee due date. While patentee indicates he had established a "method" with Attorney Aubel, the particulars of this "method" were not disclosed. As neither patentee nor Attorney Aubel acknowledges that either or both were aware of the need to pay the maintenance fee and that either or both were in fact tracking the maintenance fee for payment, the failure to timely remit the maintenance fee cannot be found to have been unavoidable.

Ultimately patentee bears the responsibility for timely remittance of the maintenance fee. The petition fails to establish that patentee was unavoidably delayed in making the payment. Accordingly, the Office is precluded from accepting the maintenance fee and surcharge. If reconsideration of this decision is not desired, petitioner may request a refund of this fee by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

Any renewed petition must establish that the entire period of delay from the time that the maintenance fee was due until the time of the filing of a grantable petition has been unavoidable. Petitioner is reminded that any renewed petition should entail an exhaustive effort to establish that the failure to timely pay the maintenance fee was unavoidable as after reconsideration pursuant to 37 CFR 1.378(e), no further reconsideration regarding unavoidable delay will be undertaken.

Petitioner must establish that patentee was aware of the need to pay the maintenance fee, and was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due until the filing

of a grantable petition. Petitioner must establish a nexus between the events complained of and the failure to timely remit the maintenance fee.

Petitioner may wish to submit statements of facts from his attorneys; copies of any contractual agreements between the attorneys and patentee whereby the attorneys was engaged to track the maintenance fee; copies of any reminder letters received from the attorneys to patentee concerning maintenance fees for the patent; and, a detailed statement concerning the system in place for tracking the maintenance fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

The requested revocation of power of attorney/change of address has been entered into the record.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions